REMARKS

Claims 1-4 and 16-29 are pending in the present patent application. Applicant amends Claims 24, 28 and 29. Applicant adds Claims 30-48. Consideration and examination of pending Claims 1-4, 16-29 and 30-48 is respectfully requested.

Examiner Interview

A first Examiner's Action (paper no. 6), or First Action, was issued in the present patent application that rejects Claims 1-4 and 16-29. On July 16, 1998, Applicant spoke with the Examiner regarding the Examiner's grounds for rejection of Claims 1-4, 16-21 and 24. Specifically, the grounds for rejection stated by the Examiner in the First Action fail to address the elements of the pending claims. The Examiner indicated that she would correct this mistake in the next Examiner's Action, if one is needed. Further, the Examiner indicated that a next Examiner's Action would be issued as a non-final Action.

The Examiner's Grounds of Rejection of Claims 1-4 and 16-21 and 24

Since the Examiner's rejection does not identify those portions of the pending claims that are rendered obvious by Richek, Applicant does not have the opportunity to respond specifically to the Examiner's rejection of Claims 1-4, 16-21 and 24. To allow Applicant a fair opportunity to reply to any future rejection of the claims, Applicant respectfully requests the Examiner to identify with particularity the grounds for rejection with reference to

particular elements of the claims and the prior art relied upon by the Examiner.

Further, in the grounds for rejection of the claims, the Examiner initially admits that Richek does not specifically detail instance and constraint, exactly as claimed in the patent application. However, the Examiner then states that it would have been obvious to a person of ordinary skill in the art that Richek's configuration file statement is the same as the claimed instance and the claimed constraint is the same as Richek's conflicts.

Given the Examiner's position that Richek does not detail an instance and constraint, Applicant contends that it is incongruous for the Examiner to then state that it would have been obvious to one of ordinary skill that Richek's configuration file statement is the same as an instance, or that a constraint is the same as Richek's conflicts. Applicant submits that the statements regarding instance and constraint are ambiguous. Applicant requests that the Examiner clarify her position on instance and constraint with reference to the pending claims, if the Examiner maintains this basis for rejection of the claims.

Rejection of Claims 1-4 and 16-21 and 24 Based on 35 U.S.C. § 103(a)

Richek does not teach, suggest or describe the claimed subject matter of the present patent application. For example, Richek fails to teach, suggest or describe creating instances of elements of a model in response to configuration requests. In Richek, the user (referred to as the integrator in Richek) identifies the boards of a computer system to which the user wishes

to allocate system resources before the user invokes Richek's configuration method. As described in Richek, Richek's configuration process merely allocates system resources to the boards identified by the user. Richek does not generate a system configuration by creating instances of elements of a model. The configuration method of Richek merely allocates computer resources to the boards specified by the user.

As stated in Richek (col. 37, lines 28-37):

"[w]hen the integrator has stored on the board configuration file diskette a configuration file or information for all boards that the integrator wishes to configure in the computer system, the integrator selects the configure option and control proceeds to step 500 (FIG. 4) where the configuration option actually commences. Based on the stored board configuration files, the system configures the options in step 502 by using the configuration method as described in the ALLOCATE, PROCESS and BACKTRACK subroutines 1100, 1200 and 1300."

Thus, the user determines the boards that are to be processed by Richek prior to invoking Richek's configuration process. When invoked by the user, Richek's configuration process merely allocates resources to those boards previously identified by the user.

Applicant submits that Richek is incapable of creating components to configure a system. This is clear from Richek's description of its technique for eliminating resource allocation conflicts that occur during its' configuration process. In Richek, a board is processed by determining what, if any, resources specified in the board's configuration file can be allocated to the board. If a resource that is specified in a board's configuration file is already allocated, a

conflict arises in Richek. Richek attempts to resolve a resource allocation conflict by determining whether the previously allocated resource can be shared, an alternate resource can be used, or the previously allocated resource can be freed for use with the current board. If none of these alternatives are successful, Richek's final alternative is to generate an error.

Richek does not create components to configure a system. In Richek, the user identifies the components of the computer system before invoking Richek's configuration process. Further, during its' configuration process, Richek does not create components of the system. Richek's configuration process is used merely to allocate a computer system's resources to the system boards identified by the user prior to invoking Richek's configuration process.

Unlike Richek, the claimed subject matter of the present invention is directed to creating components to configure a system. Therefore, for at least this reason, Richek does not teach, suggest, or describe the claimed subject matter.

Rejection of Claims 1-4 and 16-29 based on Non-Statutory Double Patenting

The Examiner rejects Claims 1-4 and 16-29 based on the judicially created doctrine of obviousness-type double patenting. The Examiner states that Claims 1 and 3-7 are rejected as being unpatentable over Claims 1-6 of U. S. Patent No. 5,515,524. The Examiner states that:

> "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person of ordinary skill to practice the broadly claimed invention of

claims 1-4 and 16-29 of the instant application without diverting from the scope of the claims 1-6 of patent number 5,515,524."

Applicant encloses herein a terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) thereby obviating the judicially created double patenting rejection. Applicant submits that Claims 1-4 and 16-29 are in condition for allowance.

Objection to Claims 22, 23 and 25-29

The Examiner objects to Claims 22, 23 and 25-29 as being dependent upon a rejected base claim. However, the Examiner states that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has added new Claims 34-40. Applicant believes that these new claims are in condition for allowance.

New Claims

In addition to Claims 33-39, Applicant has added new Claims 30-32 and 40-48. Applicant submits that new Claims 30-48 are fully supported by the specification, claims, and figures as originally filed, and that no new matter is added.

Conclusion

For the foregoing reasons, Applicant contends that none of the references cited, either alone or in combination, teach, describe, or suggest the present invention. Applicant contends that pending Claims 1-4, 16-29 and 30-48 are in condition for allowance.

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Respectfully submitted,

Hecker & Harriman

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